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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/748,495 | 12/22/2000 | Edward Zhihua Cai | | 4116 |

7590 10/25/2002
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| EXAMINER | |
| WEINSTEIN, STEVEN L | |
| ART UNIT | PAPER NUMBER |

1761
DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/948495

Applicant(s)

CAI

Examiner

S. WEINSTEIN

Group Art Unit

1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/28/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-66, 68-78 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-66, 68-78 are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Restriction to one of the following invention is required under 35 USC 121.

✓ Group I, claims 1-5, 11-40, 47-57 and 68-78, drawn to a cartridge or coffee cartridge for use with a mounting head, classified in class 426, subclass 77.

Group II, claims 66, drawn to a cartridge for use with a holder, classified in class 426, subclass 82.

Group III, claims 6-10 and 41-46, drawn to a method of making a beverage, classified in class 426, subclass 433.

Group IV, claims 58-65, drawn to a cartridge connector classified in class 99, subclass 295.

The invention are distinct, each from the other, because the cartridge of Group I and Group II can be used in methods other than that recited in Group III. For example, the cartridge could be used in a beverage making process wherein gravity feed liquid flow rather than pressurized liquid flow is used. The cartridge could even be used in the same manner as a tea bag and just immersed in a liquid. Also, the cartridge connector, as recited in Group IV, could be used to connect cartridges which do not contain a beverage ingredient at all and just contains filtering materials such as activated charcoal or zeolites to produce purified water. Also, Group I and Group II are two distinct inventions with different structures and different manners of use.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art requiring separate searches as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

In addition, this application contains a number of species and depending on which invention applicant chooses, applicant should review the claims in light of the following election of species.

This application contains claims directed to the following patentably distinct species of the claimed invention:

✓ Species A, wherein the cartridge is one single, integral body or

Species B, wherein the cartridge is a two piece construction

Species C, wherein the forming and locking comprise holding and rotating the cartridge
or

Species D, wherein the forming and locking comprises comprise a needle or

Species E, wherein the forming and locking comprises pushing a latch or pin by a spring

Species F, wherein the cartridge inlet is recessed into the upper chamber or

Species G, wherein the cartridge inlet is protruded above the upper chamber

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

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thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To expedite prosecution, it is noted that the claims are replete with phrases which would be considered indefinite under 35 USC 112, second paragraph. For example, the phrase "such as" is used throughout the claims. "Such as" is an indefinite phrase since it would not be clear as to the scope of such a phrase. Applicant should consider the use of Markush groupings. The phrase "flavor - containing or particle materials" would also be unclear. How do they differ? Are they alternative equivalents. Other errors exist as well. Claim 1 only recited a cartridge "for" use and a chamber "for" containing suitable ... materials". Thus, claim 1 does not positively recite the beverage making ingredients so that one would have a closed cartridge with nothing in it. Also, claim 6 would then be indefinite as well since it recites making a beverage but the cartridge does not positively recite a beverage. Claim 8 is another example of an

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indefinite "such as" phrasing. Applicant is urged to review all of the claims and make appropriate changes and submit such amendment along with the response to this restriction requirement in order to expedite prosecution. Note, too, the preamble of claim 68 (formerly 69) should read a beverage cartridge, not cartridge connector.


Applicant has already made an error in claim numbering. With the cancellation of original claim 67, original claims 68-70 should not have been renumbered 67-69. They should keep their original numbering and the new claim 70 should be numbered as the next consecutive number which would be 78.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Weinstein whose telephone number is 703-308-0650. The examiner can generally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

S. Weinstein/mn
October 24, 2002


STEVE WEINSTEIN
PRIMARY EXAMINER 1761
10/25/02